

the record unclear. As the form itself indicates, a line through the citation indicates that the citation was not considered. There is no policy or practice of the PTO not to cite a copending application on the face of a printed patent. If the Examiners persist in the position taken at the top of page 2 of the Office Action, they are respectfully requested to cite authority for this position.

Claims 2-6 and 8 have been objected to as containing parenthetical information that creates ambiguous claim language and allegedly makes the claims unclear. Reconsideration of this objection is respectfully requested as the parenthetical expressions simply clarify, rather than confuse, the bases on which the weight percentages of the identified oxides are calculated. Rather than causing confusion, the parenthetical expressions add clarity and precision to the limitations of these claims. Accordingly, the Examiners are requested to withdraw this objection.

At the top of page 3 of the Office Action, an inaccurate observation is made that the present application was not filed on or after November 29, 2000. This application was filed on November 13, 2001, well after the effective date of the changes to Section 102(e). Although this observation is inaccurate, it does not appear to affect any of the rejections made in the Office Action.

Claims 1-8 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Belleville et al. (U.S. Patent No. 6,387,517). This rejection is traversed. The Examiners have relied upon the teachings of Belleville et al. at column 7, lines 6-16, as teaching that a reflecting material may be made from a polymer layer comprising tantalum oxide that may contain at least one other metal or metalloid oxide in a proportion of from 1 to 99% by mass of oxides that include those recited in claim 1, for example. However, in

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order to anticipate a claim, a single prior art reference must specifically or inherently describe each and every limitation set forth in the claim. *Verdegaal Bros, Inc. v. Union Oil Co.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Inherent anticipation requires that the missing descriptive material is necessarily present, not merely probably or possibly present in the prior art. *In re Robertson*, 49 USPQ2d 1049, 1050-51 (Fed. Cir. 1999).

With these general principles of anticipation in mind, there is clearly no teaching of any composition in Belleville et al. of the combination of oxides recited in claims 1-8. Still further, there is no teaching or even possibility of inherency of a composition containing the percentages of oxides specified in claims 3-8.

In addition to the lack of anticipation, Belleville et al. neither teaches nor suggests nor otherwise motivates a person skilled in the art to select three oxides recited in claim 1 or any other claim present in this application in combination. Absent such a teaching or motivation, the mere fact that it may be possible to select oxides from among the oxides suggested by Belleville et al. is simply not sufficient to establish a *prima facie* case of obviousness. As noted in *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990), the mere fact that a prior art teaching could be modified to meet the limitations of the present claims is not sufficient to make the modification obvious unless the prior art suggests the desirability of the modification. As the limitations of claims 1-8 are neither anticipated nor rendered obvious by Belleville et al., this rejection should be withdrawn.

Claims 9-11 and 13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Belleville et al. in view of Lindmayer (U.S. Patent No. 4,246,043).

The Examiners recognize that Belleville et al. lacks any reference to the use of vaporization as a means for creating an antireflective coating, but rely on the teachings

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of Lindmayer for the use of evaporation as a means of placing a coating on a substrate (e.g., column 3, lines 23-24). This rejection is also traversed.

This rejection is unsound for the reasons noted above regarding the total failure of the teachings of Belleville et al. to teach or suggest the combination of oxides and their proportions, where applicable, recited in these claims. Lindmayer clearly does not address the combination of oxides required by these claims and would not establish a *prima facie* case of obviousness of the claimed invention, either alone or in combination with Belleville et al., simply because all of the claim limitations have not been satisfied.

Still further, however, Lindmayer does not teach the combination of steps of sintering, vaporizing the resulting oxide, and depositing the vapor on a surface as recited in these claims. Even though each of these steps may be conventional in the art per se, this is insufficient to establish a *prima facie* case of obviousness in the absence of some teaching or suggestion to combine these individually old steps in the manner required by the present claims. Finally, Belleville et al. teaches away from the claimed invention in that this patent teaches formation of a polymer coating with optical properties that avoids using physical deposition processes. See column 1, lines 49-64 of Belleville et al. For any and all of these reasons, this rejection should be withdrawn.

Claims 12 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Belleville et al in view of Lindmayer and Knapp et al. (U.S. Patent No. 5,846,649). The Examiners recognize that neither Belleville et al. nor Lindmayer teach the use of an ion-assisted process in the creation of antireflective layers, but have relied on the teachings of Knapp et al. (e.g., column 5, lines 23-24) as teaching that such a process is well known. This rejection is also traversed.

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The method of claim 12 and the film of claim 14 are considered to be both novel and unobvious over the combined teachings of Belleville et al., Lindmayer and Knapp et al. The additional patent to Knapp et al. added in this rejection does not cure any of the fundamental deficiencies in the teachings of the Belleville et al. and Lindmayer teachings that have been identified and argued above. Accordingly, since the combination of patents relied on in this rejection does not establish a *prima facie* case of obviousness, this rejection should be withdrawn.

Claims 15 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Belleville et al. in view of Lindmayer and in further view of Asai et al. (U.S. Patent No. 5,116,644). In addition to the teachings of Belleville et al. and Lindmayer discussed above, the Examiners have relied on the teachings of Asai et al. for the use of a hardcoat layer (e.g., at column 1, lines 33-34) in combination with the substrate and an antireflective coating. This rejection is traversed for substantially the same reasons advanced above concerning the failure of Belleville et al. and Lindmayer to teach or suggest the unique combination of oxides required in these claims. Accordingly, this rejection should be withdrawn.

Claim 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Belleville et al. in view of Lindmayer, Knapp et al. and Asai et al. This rejection is also traversed for the reasons set forth above. The mosaic of prior art patents relied upon by the Examiners simply fail to teach or suggest an antireflection film containing a combination of oxides of the present invention. In the absence of such a teaching, an essential element of a *prima facie* case of obviousness is missing from this combination. Accordingly, this rejection should be withdrawn.

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Applicants acknowledge, with appreciation, the clear and detailed Office Action with a separate treatment of the claims. The prior art relied upon by the Examiners, however, simply is not sufficient to anticipate or establish a *prima facie* case of obviousness. Accordingly, prompt and favorable reconsideration of this application is requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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